

## REMARKS

### I. Summary of the Office Action

Claims 1-59 are pending in this application.

The Examiner contends that an Information Disclosure Statement filed on December 12, 2001 fails to comply with 37 C.F.R. § 1.98(a)(3) because it does not contain a concise explanation of relevance of a non-English language reference.

The drawings are objected to under 37 C.F.R. § 1.84(p)(5) for including reference numbers not mentioned in the description.

Claims 1, 2, 6, 19, 20, 24-27, 35, 36, 49, 50, and 52-54 are rejected under 35 U.S.C. § 102(e) as being anticipated by Dimitri et al. U.S. Patent No. 6,574,424 (hereinafter "Dimitri").

Claims 1, 3-6, 12-19, 21-23, 28-35, 37-39, 45-49, 51, and 56-59 are rejected under 35 U.S.C. § 102(e) as being anticipated by Arai et al. U.S. Patent No. 6,486,920 (hereinafter "Arai").

Claims 1-59 are rejected under 35 U.S.C. § 103(a) as being obvious from Young et al. U.S. Patent No. 5,353,121 (hereinafter "Young") in view of Zigmond et al. U.S. Patent No. 6,698,020 (hereinafter "Zigmond").

## II. Summary of Applicants' Reply

Applicants are submitting concurrently herewith a Form PTO/SB/08A (in duplicate) and a copy of an English-language abstract for Japanese Laid-Open Publication No. JP 3063990 A.

Applicants have amended the specification to mention reference numbers shown in the drawings. Claims 3, 19-34, 37, and 49-59 have been canceled without prejudice. Independent claims 1 and 35 have been amended to incorporate the features of claims 3 and 37, respectively. Claims 4 and 5 and claims 38 and 39 have been amended to refer to independent claims 1 and 35, respectively. No new matter has been introduced as a result of these amendments.

The Examiner's objection and rejections are respectfully traversed.

## III. Information Disclosure Statement

Applicants filed an Information Disclosure Statement on October 26, 2001 in connection with this application. A copy of a receipt postcard for the Information Disclosure Statement, date-stamped, is enclosed.

The Examiner indicates that JP 03063990, which was cited in the October 26, 2001 Information Disclosure

Statement\* was not considered because it was not accompanied by a concise explanation of its relevance to this application.

Pursuant to 37 C.F.R. § 1.98, applicants are submitting herewith a Form PTO/SB/08A (in duplicate) that lists the foreign patent document and a copy of an English-language abstract of the foreign patent document. Applicants respectfully request that the Form PTO/SB/08A, as considered and initialed by the Examiner, be returned with the next communication.

Applicants do not believe that any fee is due in connection with the resubmission of this foreign patent document in view of the earlier submission of the document as evidence by the return postcard and the fact that the Information Disclosure Statement was filed before the mailing of a first Office Action.

#### IV. Applicants' Reply to the Objection

The Examiner objects to the drawings under 37 C.F.R. § 1.84(p)(5) for including reference numbers not mentioned in the description. Applicants have amended the

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\* The Examiner refers to an Information Disclosure Statement filed on December 12, 2001, but applicants did not file any Information Disclosure Statement on December 12, 2001. Applicants assume that the Examiner is referring to the Information Disclosure filed on October 26, 2001.

specification to mention reference numbers shown in the drawings. This objection should therefore be withdrawn.

V. Applicants' Reply to the § 102 Rejection

A. The Dimitri Reference

The Examiner rejects claims 1, 2, 6, 19, 20, 24-27, 35, 36, 49, 50, and 52-54 under 35 U.S.C. § 102(e) as being anticipated by Dimitri. This rejection is respectfully traversed.

Applicants have canceled claims 19, 20, 24-27, 49, 50, and 52-54 without prejudice. Accordingly, the rejection of claims 19, 20, 24-27, 49, 50, and 52-54 in view of Dimitri is moot and should therefore be withdrawn.

Applicants have amended independent claims 1 and 35 to incorporate the features of claims 3 and 37, which were not rejected in view of Dimitri. Accordingly, amended independent claims 1 and 35 and dependent claims 2, 4-18, 36, and 38-48 are allowable in view of Dimitri. Therefore, the rejection in view of Dimitri should be withdrawn.

B. The Arai Reference

The Examiner rejects claims 1, 3-6, 12-19, 21-23, 28-35, 37-39, 45-49, 51, and 56-59 under 35 U.S.C. § 102(e) as being anticipated by Arai. This rejection is respectfully traversed.

Applicants have canceled claims 3, 19, 21-23, 28-34, 37, 49, 51, and 56-59 without prejudice. Accordingly, the rejection of claims 3, 19, 21-23, 28-34, 37, 49, 51, and 56-59 in view of Arai is moot and should be withdrawn.

Applicants' invention, as defined by amended independent claims 1 and 35, is directed towards a method and a system for providing promotions with recorded programs. A program is selected to be recorded based on user input and a promotion is selected to be recorded. The program and the promotion are caused to be recorded.

Arai discusses a receiving apparatus, which receives program information and commercial positioning information, which may be used in connection with recording programs. When a user selects a program for recording, the user may also select whether or not to record commercials.

Applicants submit that Arai fails to show or suggest selecting a promotion to record, as required by amended independent claims 1 and 35. When recording programs in Arai, users may elect not to record regularly broadcast commercials with the programs (see Arai, column 16, lines 47-50). For example, Arai discusses using commercial positional information to avoid recording commercials. This is different from selecting promotions to record. When a

commercial is recorded with a program in Arai, the commercial is one that has been pre-determined to be broadcast with television programming by a television network and/or its local affiliate. Arai does not discuss selecting any of these commercials for recording.

For at least this reason, amended independent claims 1 and 35 and dependent claims 3-6, 12-18, 35, 37-39, 45-48 are allowable over Arai. Therefore, the rejection in view of Arai should be withdrawn.

VI. Applicants' Reply to the § 103 Rejection

The Examiner rejects claims 1-59 under 35 U.S.C. § 103(a) as being obvious from Young in view of Zigmond. This rejection is respectfully traversed.

Applicants have canceled claims 3, 19-34, 37, and 49-59 without prejudice. Accordingly, the obviousness rejection of claims 3, 19-34, 37, and 49-59 is moot and should be withdrawn.

Young discusses, among other things, a television schedule system that allows users to select a program for recording.

Zigmond discusses inserting advertisements into a video programming feed at the household level.

Applicants submit that the Examiner has not provided a sufficient motivation for combining Young and Zigmond to establish a prima facie case of obviousness. The Examiner contends that the motivation for combining Young and Zigmond is "for the purpose of providing a means to specifically target, deliver, and present individually targeted advertisements to viewers regardless of the sources of the media in order to effectively reach the consumer" (Office Action, page 7, lines 6-9). Applicants submit that Zigmond itself discusses inserting advertisements into recorded programming, and therefore, it would not have been obvious to combine Zigmond and Young to achieve the same outcome (i.e., insert advertisements into recorded programming). For example, Zigmond discusses determining appropriate advertisements to insert based on "whether the video programming feed is watched as it is broadcast or being replayed from recorded media" (Zigmond, column 14, lines 2-4).

Moreover, it is an important objective in Zigmond that the response of the viewers to the advertisements be accurately measured (see Zigmond, column 4, lines 1-3). Zigmond's approach to using an ad insertion device to insert advertisements during the playback of a recorded program

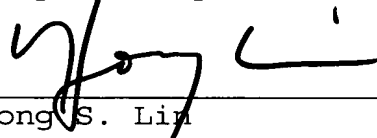
meets this objective because the ad insertion device can measure the response of a viewer to the advertisement as it is being viewed. However, there is no discussion by either Young or Zigmond to meet this objective when a viewer is viewing a promotion that has been previously recorded by a VCR.

For at least these reasons, claims 1, 2, 4-18, 35, 36, and 38-48 are not obvious from Young in view of Zigmond. This rejection should therefore be withdrawn.

VII. Conclusion

In view of the foregoing, claims 1, 2, 4-18, 35, 36, and 38-48 are allowable. This application is therefore in condition for allowance. Reconsideration and allowance of this application are respectfully requested.

Respectfully submitted,



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